APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,866	12/03/2004	Andreas Witzel	P17157US1	2414

27045	7590	12/06/2006	EXAMINER

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ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		10/516,866	WITZEL ET AL.
		Examiner	**Art Unit**
		Kwasi Karikari	2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>13 November 2006</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to claims 1-20 have been considered but are

moot in view of the new ground(s) of rejection.

In response to applicant's argument that the Ejzak's reference fails to show

certain features of applicant's invention, it is noted that the features upon which

applicant relies (i.e., "determining...incoming request", see applicant's

remarks/arguments pages 9 of 11) are not recited in the rejected claim(s). Although the

claims are interpreted in light of the specification, limitations from the specification are

not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed.

Cir. 1993).

For further clarification, Ejzak's reference discusses a system that provides

service to a User Equipment, via a circuit- switch MCS that uses call control protocol or

via a IP Multimedia Subsystem that uses Session Initiation Protocol; and the

determination whether UE is process as MSC or iMSC (see Pars. 0003-4, 0013 and

0094-98).

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of
making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to
which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the
best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. The amended claimed limitations "identifying the

protocol associated with the communications service request", in claims 1 and 20 are

not clearly described in the specification as originally filed and these constitute new

matter. For examination purposes, the examiner will treat the rejected claimed language

in light of the specification. All claims that depend on the above rejected claims are also

rejected for fully incorporating the deficiencies of the above rejected claims from which

they depend. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the

Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a

U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore,

the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-

AIPA 35 U.S.C. 102(e)).

Claims 1-17,19 and 20 are rejected under U.S.C. 102(e) as being

anticipated by Ejzak (20030027569 A1), (hereinafter Ejzak).

Regarding **claim 1,** Method for operating a switching node (iMSC in 151 interworking

with 141, Pars. [0029 and 0046-47] and Fig. 1) of a communications network comprising

the steps of:

receiving a communication service request; processing the requested

communications service;(UE 111 initiates mobile call, see Fig. 5 steps 501 and 502);

determining an operation mode of the switching node <u>by identifying the protocol</u>

<u>associated with the communications service request</u> wherein the determined

operation mode indicates whether the switching node is <u>operative</u> for the processing

of the requested communication service part of a layered architectural environment

(see Par. [0046]) providing a user plane layer for user data and a control plane layer for

signaling data (determination for the system to serve as traditional MSC or iMSC server,

see Par. [0012, 0095-96] and Fig. 4, steps 403 and 404) , or

part of a non-layered architectural environment not providing a split between a

user plane and a control plane (serving system acts as iMSC or MSC server, see Par.

[0021, 0094, 0101] and Fig. 4, step 408), and wherein the processing of the requested

communications service comprises the operating of the switching node in the

determined operation mode (see Pars. [0013, 0052-54 and 0079]) .

Regarding **claim 2,** as recited in claim 1, Ejzak discloses the method, wherein the

communications service request is a call set-up request (see Pars. [0104-07]).

Regarding **claim 3,** as recited in claim 1, Ejzak discloses the method, wherein the

operation mode is determined according to at least one predetermined rule, which is

set-up according to available network capabilities (SIP for IMS internet-like functionality

and services, see Pars. [0020-21 and 0028], whereby the protocol is associated with

"predetermined rule").

Regarding **claim 4,** as recited in claim 1, Ejzak discloses the method, wherein a plurality

of incoming routes (signaling link and signaling and data links) from an access network

(RAN 121) to the switching node are provided, at least one predetermined rule

comprises an assignment of a dedicated incoming route (signaling link) to an operation

mode of the switching node, and wherein the step of determining the operation mode

comprises a determination of an incoming route of the communication service request

and a comparison of the determined incoming route against at least one predetermined

rule (see Par. [0034-35]).

Regarding **claim 5,** as recited in claim 1, Ejzak discloses the method, wherein at least

one predetermined rule comprises an assignment of a dedicated access technology to

an 6peration mode, said dedicated access technology provided by an access network

for serving a subscriber terminal (UE 111) of a communication system comprising the

switching node, and wherein the step of determining the operation mode comprises the

determination of the access technology used by the subscriber terminal and comparison

of the determined access technology against at least one predetermined rule

(communication system; 3G CDMA , see Pars. [0020 and 0024]).

Regarding **claim 6,** as recited in claim 1, Ejzak discloses the method, wherein the

communication service request comprises an identifier of a communications service

terminating party, at least one predetermined rule comprises an assignment of the

identifier to a dedicated operation mode, and wherein the step of determining the

operation mode comprises a determination of the identifier and a comparison of the

determined identifier against at least one predetermined rule (SIP signaling between

two 3GPP UE 111, see Par. [0080], whereby the 3GPP is associated with the

"identifier ").

Regarding **claim 7,** as recited in claim 1, Ejzak discloses the method, wherein at least

one predetermined rule indicates by means of a statistical distribution factor a

distribution, for how many received communications service requests the switching

node shall operate as a switching node of the layered architectural environment or as a

switching node of the non-layered architectural environment, and wherein the

determined operation mode depends on the statistical distribution factor

(see Pars. [0038, 0052 and 0055]).

Regarding **claim 8,** as recited in claim 1, Ejzak discloses the method, wherein the

determination of the operation mode comprises a determination of a current load level

of the switching node in at least one operation mode, and wherein the determined

operation mode for the processing of the requested communications service depends

on the determined load level (see Par. [0037]).

Regarding **claim 9,** as recited in claim 1, Ejzak discloses the method, wherein the

communication service request requests a subscriber terminal terminating

communications service, wherein at least one predetermined rule comprises an

assignment of an access technology available to the subscriber terminal to a dedicated

operation mode, and wherein the step of determining the operation mode comprises the

determination of the access technology available to the terminating subscriber terminal,

and the determined operation mode depends on the determined access technology

(see Pars. [CDMA and 3GPP, see [0020 and 0080]).

Regarding **claim 10,** as recited in claim 1, Ejzak discloses the method, wherein the

switching node processes the requested communications service as a MSC/VLR, if the

determined operation mode indicates that the switching node is part of the non-layered

architectural environment (see Par. [0012-13 and 0095-96]).

Regarding **claim 11,** as recited in claim 1, Ejzak discloses the method, wherein the

switching node processes the requested communications service as a MSC-server, if

the determined operation mode indicates that the switching node is part of the layered architectural environment (iMSC server, see Pars. [0095-97] and Fig. 4, step 408).

Regarding **claim 12,** as recited in claim 1, Ejzak discloses the method, wherein the determination of the operation mode comprises a determination of at least one of a group of an origin of the communications service request and a destination of the communications service request, and wherein the determined operation mode depends on the at least one determined member of the group (see Pars. [0089-91]).

Regarding **claim 13,** as recited in claim 1, Ejzak discloses the method, wherein the switching node is determined operatively to process the requested communication service as part of the non-layered architectural environment, if an origin of the communications service request, in particular an originating radio network node, is local to the switching node, and a destination indicated by the communications service request is local to the switching node (see Pars. 0089-91 and 0103).

Regarding **claim 14,** as recited in claim 1, Ejzak discloses the method, wherein the switching node is determined operatively to process the requested communication service as part of the layered architectural environment , if an origin of the communications service request, in particular an originating radio network node, is remote to the switching node, and a destination indicated by the communications service request is remote to the switching node (see Pars. 0089-91 and 0103).

Regarding **claim 15,** as recited in claim 14, Ejzak discloses the method, wherein the

switching node applies local switching, if an origin of the communications service

request, in particular an originating radio network node, is local to the destination

indicated by the communications service request (see Par. [0081]).

Regarding **claim 16,** as recited in claim 1, Ejzak discloses the method, wherein the

switching node is determined operatively to process the requested communication

service as part of the layered architectural environment, if an origin of the

communications service request, in particular an originating radio network node, is

remote to the switching node, and a destination indicated by the communications

service request is local to the switching node (service base on location,

see Par. [0081]).

Regarding **claim 17,** as recited in claim 1, Ejzak discloses the method, wherein the

switching node is determined operatively to process the requested communication

service as part of the layered architectural environment, if an origin of the

communications service request, in particular an originating radio network node, is local

to the switching node, and a destination indicated by the communications service

request is remote to the switching node (see Par. [0079-81]).

Regarding **claim 19**, Ejzak discloses a network node, in particular a combined

MSC/VLR (tradition MSC) and MSC-server (MSC server or iMSC server) (see Par.

[0012-13] and Fig. 1, comprising:

an access network interface for the user plane (interface between 111 and RAN

121, see Fig. 1)

an access network interface for the control plane (see Pars. [0025 and 0030]),

a core network interface for the user plane (see Pars. [0030-32]),

a core network interface for the control plane, a media gateway interface

(see Pars. [0030, 0036 and 0047-48]),

a media gateway operation unit connected to the user plane interfaces adapted

to provide media gateway functions (see Pars. [0025 and 0030 and 0036]),

a MSC-server operation unit connected to the control plane interfaces and to the

media gateway interface, the MSC-server operation unit adapted to provide Msc-server

functionality (MSC server 152, and iMSC 201),

a selection unit adapted to determine for a communication service request (call

set up, see Figs. 4 and 5), an operation mode for a processing of the requested

communication service by identifying the protocol associated with the communications

service request, wherein the determined operation mode indicates whether the network

node is operatively for the processing of the requested communication service part of a

layered architectural environment providing a user plane layer for user data and a

control plane layer for signaling data (determination for the system to serve as

traditional MSC or iMSC server, see Par. [0012, 0095-96] and Fig. 4, steps 403 and

404), or operatively part of a non-layered architectural environment not providing a split

between a user plane and a control plane and a processor connected to the interfaces

and units of the switching node, said processor being adapted to process a requested

communications service in accordance with a determined operation mode of the

network node (see Par. [0096-0100] and Fig. 4, steps 408 and 420).

Regarding **claim 20,** as recited in claim 19, Ejzak discloses the node comprising

means for storing (HSS 142), in particular a lookup table, network node identifiers and

related indications, indicating whether the identified network nodes are local or remote

to the network node (see Pars. [0048-52).

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Kauhanen (U.S. 20030157935) teaches an intersystem handover with modified

parameter.

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-F (8 am - 4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kwasi Karikari
Patent Examiner.
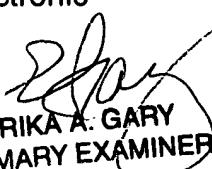
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